

In the Claims: (strikethrough parts deleted and underlined parts added)

Please delete Claims 6, 7, 8, 16, 17, 18 without prejudice.

1. (Currently Amended) A suet bird feeder system, comprising:
a housing unit ~~an opening with a rear wall~~, wherein said housing includes a plurality of openings, wherein at least one pair of openings within said housing have a common rear wall;
a support member extending ~~from said rear wall~~ through said common rear wall into each of said pair of openings; and
a suet plug formed to fit within said plurality of openings ~~opening~~.
2. (Currently Amended) The suet bird feeder system of Claim 1, wherein said ~~opening~~ has plurality of openings each have a straight or tapered inner wall and wherein said suet plug has a tapered sidewall formed to fit within said plurality of openings ~~opening~~.
3. (Currently Amended) The suet bird feeder system of Claim 1, wherein said support member extends concentrically from said common rear wall.
4. (Original) The suet bird feeder system of Claim 1, wherein said support member has a spiked end.
5. (Currently Amended) The suet bird feeder system of Claim 1, wherein said support member extends at least 25% of the length of said plurality of openings ~~opening~~.
6. (Cancelled)
7. (Cancelled)
8. (Cancelled)

9. (Currently Amended) The suet bird feeder system of Claim 1 8, wherein distal portions of said support member are spiked structures.

10. (Currently Amended) The suet bird feeder system of Claim 1, wherein said suet plug is similar in size and shape to said plurality of openings ~~opening~~.

11. (Currently Amended) The suet bird feeder system of Claim 11, including a storage tray having a plurality of storage cavities having a tapered structure for receiving and storing said suet plugs prior to insertion within said plurality of openings ~~opening~~.

12. (Currently Amended) The suet bird feeder system of Claim 11, wherein said plurality of openings ~~have~~ ~~opening~~ has a straight or tapered inner wall and wherein said suet plug has a tapered sidewall formed to fit within said opening.

13. (Currently Amended) The suet bird feeder system of Claim 11, wherein said support member extends concentrically from said common rear wall.

14. (Original) The suet bird feeder system of Claim 11, wherein said support member has a spiked end.

15. (Original) The suet bird feeder system of Claim 11, wherein said support member extends at least 25% of the length of said plurality of openings ~~opening~~.

16. (Cancelled)

17. (Cancelled)

18. (Cancelled)

19. (Currently Amended) The suet bird feeder system of Claim 11 ~~48~~, wherein distal portions of said support member are spiked structures.

20. (Currently Amended) The suet bird feeder system of Claim 11, wherein said suet plug is similar in size and shape to said plurality of openings ~~opening~~.

Please add the following claims:

21. (New) A suet bird feeder system, comprising:
a housing unit having at least one opening with a rear wall;
a support member extending from said rear wall;
a suet plug formed to fit within said opening; and
a storage tray having a plurality of storage cavities having a tapered structure for receiving and storing said suet plugs prior to insertion within said opening.

22. (New) The suet bird feeder system of Claim 21, wherein said opening has a straight or tapered inner wall and wherein said suet plug has a tapered sidewall formed to fit within said opening.

23. (New) The suet bird feeder system of Claim 21, wherein said support member extends concentrically from said rear wall.

24. (New) The suet bird feeder system of Claim 21, wherein said support member has a spiked end.

25. (New) The suet bird feeder system of Claim 21, wherein said support member extends at least 25% of the length of said opening.

26. (New) The suet bird feeder system of Claim 21, wherein said suet plug is similar in size and shape to said opening.

D. APPLICANT'S COMMENTS

Claims 1-5, 9-15, 19, 20 are pending in this Application, with Claims 6, 7, 8, 16, 17, 18 cancelled, with Claims 1, 2, 3, 5, 9, 10, 11, 12, 13, 19, 20 being amended and Claims 21-26 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-5, 9-15, 19, 20 and favorable consideration of Claims 21-26 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 1 of the Official Action

The Official Action rejected Claims 1, 4-6, 10 under 35 U.S.C. §103(a) as being unpatentable over Loisel and Claims 2, 7 as being unpatentable over Loisel in view of Hyde and Claim 3 as being unpatentable over Loisel in view of Beyea. The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.